



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,381	08/08/2006	Sandrine Barranco	Q91866	2883

23373 7590 11/29/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SHEARER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

3754

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

11/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No. 10/559,381	Applicant(s) BARRANCO ET AL.	
	Examiner DANIEL R. SHEARER	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 13, and 15 recite that the valve seal “is made of a one-piece integral structure” and “does not include a rigid insert”. However, the original specification does not include any details of the structure of the seal, whether it is formed in one or multiple pieces and especially the absence of rigid inserts, but merely the components used to form the seal.

Warning

3. Applicant is advised that should claim 1 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

4. Claim 1 is objected to because of it is unclear where the preamble ends due the absence of a transitional phrase. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-5, 8-12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,836,299 to Kwon in view of U.S. Patent No. 5,565,275 to Schmidt et al. (Schmidt).

Kwon shows an aerosol dispenser for dispensing a fluid product (see abstract), comprising a reservoir (30) containing a fluid product and a propellant gas in the form of HFC-134a gas (Col. 6, ll. 8-11), a valve (12) mounted on the reservoir and a valve seal (16) made of a one piece integral structure without a rigid insert (Col. 4, ll. 66-67 and Col. 5, ll. 1-2) consisting of EPDM (see abstract) and an unknown additive such as silica (Col. 3, ll. 44-52). Kwon fails to disclose the seal including mineral filler based upon quartz and kaolinite.

Schmidt discloses a material comprised of EPDM and a mineral filler sillitin (Col. 8, example table) for use in seals (Col. 8, line 23) that result in excellent slide friction properties (Col. 8, line 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have manufactured the

Art Unit: 3754

valve seal of Kwon with mineral filler of Schmidt since Schmidt discloses that the resulting material possesses excellent slide friction properties. Further, it has been held that the selection of a known material based on its suitability for its intended use can support a conclusion of prima facie obviousness. (See MPEP 2144.06). Even further, in Column 3, ll. 34-52 Kwon invites one of ordinary skill in the art to select an additive such as silica for the EPDM. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the additive Sillitin, disclosed as a well known silicate additive by Schmidt, for the valve seal of Kwon.

Regarding claims 2-5, the mineral filler Sillitin includes a mineralogical composition of between 65% and 95% of quartz and between 5% and 35% of kaolinite, a chemical composition of between 3% and 15% of Alumina and between 75% and 95% of Silica, a pH greater than 6 and an average particle size between 1.5 and 4 microns (See NPL, material data sheet for Z86).

Regarding claim 10, Kwon shows a valve element (12) sliding in a valve body with the interposition of the valve seal.

Regarding claim 12, Kwon discloses that the reservoir contains ethanol (table in Col. 7).

7. Claims 6 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Kwon in view of Schmidt and U.S. Patent No. 5,085,005 to Yasukawa et al. (Yasukawa).

The Kwon-Schmidt combination shows all aspects of the applicant's invention as set forth in claim 1, but fails to disclose that the seal is subjected to a surface chlorination treatment. Yasukawa shows a seal (48) formed of diene rubber that is subjected to a chlorination treatment to reduce the sliding resistance of the seal (Col. 5, ll. 64-67 and Col. 5, ll. 1-6). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have subjected the seal of Kwon as modified by Schmidt to a chlorination treatment as taught by Yasukawa to reduce the sliding resistance of the seal.

Regarding claim 13, the claimed manufacturing process is inherently disclosed by the structure of Kwon as modified by Schmidt and Yasukawa as applied to claims 1 and 6 above.

8. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Kwon and Yasukawa as applied to claims 6 and 13 above, and further in view of U.S. Patent No. 6,306,514 to Weikel et al. (Weikel).

Kwon as modified by Schmidt and Yasukawa shows all aspects of applicant's invention as set forth in claims 6 and 13 but fails to specifically disclose the surface chlorination treatment comprising a solution of water, hydrochloric acid and bleach. However, Weikel discloses that a surface chlorination treatment comprising a solution of water, hydrochloric acid and bleach is a known process to change the characteristics of rubber (Col. 1, ll. 50-59). It would have been obvious to one of ordinary skill in the art to

have subjected the material of Kwon as modified by Schmidt with the treatment as taught by Weikel to achieve the desired characteristics for the material.

Response to Arguments

9. Applicant's arguments filed 9/20/2010 have been fully considered but they are not persuasive. Specifically, the Applicant argues that the limitations "wherein the valve seal is made of a one-piece integral structure and wherein the valve seal does not include a rigid insert" are supported by the original specification and figures. The Applicant asserts that Figure 1 shows the valve as a one-piece structure without a rigid insert. However, Figure 1 shows one cross section of a valve seal and only shows the structure of the valve seal at that specific location. This cannot be relied upon to show that the entire valve seal is one piece or that there are no rigid inserts in any part of the valve. The Applicant further argues that since the specification does not include any positive recitation of a rigid insert or a multiple piece structure, the recited limitations are supported. It is noted that the mere absence of a positive recitation is not basis for exclusion. See MPEP 2173.05(h). Finally, the Applicant asserts that the specification incorporates the structure of EP0969069 with the language "this present invention therefore results in improving the seal described in document EP 0 969 069" and that said document discloses a one-piece integral structure. It is noted that an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, an explicit statement that such specifically enumerated prior application or applications are "hereby incorporated by reference." The statement

Art Unit: 3754

must appear in the specification. See 37 CFR 1.57(b) and MPEP § 608.01(p).

However, mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In *re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). Therefore, the above statement is not an incorporation by reference for the purpose of disclosure required by 35 U.S.C. 112, first paragraph. Furthermore, even if the EP 0969069 document were incorporated by reference, Applicant has failed to provide any evidence that the EP 0969069 device is a one-piece integral structure and the Examiner has found no recitation in the document indicating the alleged valve seal structure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL R. SHEARER whose telephone number is (571)270-7416. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. R. S./
Examiner, Art Unit 3754

/Kenneth Bomberg/
Primary Examiner, Art Unit 3754